

REMARKS

Applicant submits that the pending Office action mailed on April 14, 2004 is defective and respectfully requests issuance of a new, proper Office action. Specifically, the action fails to enter claims 19 and 20 (listed above as new) presented with the Request for Continued Examination in a paper filed on December 3, 2003, as required by 37 C.F.R. §1.104(c). Also, the Office action raises new grounds of rejection in that claims 1-4, 8-12, 14, 15, 17 and 18 are now rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 4,463,709 to Pluequet (Pluequet) in view of U.S. Pat. No. 5,619,956 to Koziara et al. (Koziara). As these claims were presented in a submission with a Request for Continued Examination, MPEP § 706.07(b) provides that the claims may be finally rejected in the first Office action where all the claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and the art of record in the next Office action if they had been entered in the earlier application. The grounds of rejection recited above and the Koziara reference were not previously made of record and accordingly, the Office action was improperly made final and should be withdrawn.

For the reasons stated above, Applicant submits that the fee for the Petition for Extension of Time is not required. If the Applicant is in error, a charge of \$490 to deposit account 06-1050, referencing attorney number 00637-025001, for the Petition for Extension of Time fee is authorized.

Applicant also encloses a provisional Notice of Appeal contingent on the final Office action not being withdrawn. Please apply any charges to deposit account 06-1050, referencing attorney number 00637-025001.

While not required at this time, Applicant presents the following arguments to advance prosecution on the merits.

Regarding the proposed rejection of claims 1-4, 8-12, 14, 15, 17, and 18 as obvious over Pluequet in view of Koziara, Applicant respectfully submits that such a rejection would not be proper, for at least the following reasons.

Pluequet discloses an exhaust gas conduit system of simplified construction having an exhaust manifold with longitudinal water chambers formed by the walls of an insulating wall and ribs for support. Koziara discloses a catalytic conversion element positioned in an exhaust manifold without cooling passages. Pluequet provides an exhaust manifold having liquid coolant passages, but does not show a catalytic conversion element disposed within the manifold. Koziara provides an exhaust manifold containing a catalytic conversion element, but does not disclose liquid coolant passages. In other words, Pluequet discloses a liquid-cooled manifold and Koziara discloses one of what are likely several examples of catalysts being employed to reduce emissions. However, neither reference provides any suggestion or motivation for placing a catalyst, known in the art to require relatively high temperatures for effective operation, within a manifold that is liquid cooled so as to avoid relatively high temperatures. Applicant respectfully submits that one of ordinary skill would not have been motivated by a reasonable consideration of both Koziara and Pluequet to move a catalytic conversion element that is normally housed so as to allow high temperature operation, to within a liquid-cooled exhaust manifold. Liquid-cooling the housing of a catalyst is not suggested by either of these references, and contrary to typical practice. The clear theme of patent law with respect to the standards for obviousness is that, although each of the individual limitations or elements recited in a claim may be found in the prior art, it is the *combination* of such elements (here including the combination of a liquid-cooled manifold and a catalyst within the manifold) that is to be examined, as a whole.

Applicant submits that for at least the same reason, all claims depending from independent claims 1, 14 and 18 are allowable as well.

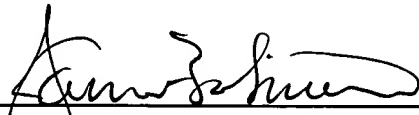
Should the above remarks be found unpersuasive, or if there remain any other substantive issues affecting allowability, Applicant respectfully requests that the undersigned attorney be granted an opportunity for a substantive telephone interview with the Examiner before any revised office action is issued.

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Attorney's Docket No.: 00637-025001

Respectfully submitted,

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